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Thomas DeWitt Smith

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/670,378
Filing Date: September 26, 2003
Appellant(s): SMITH, THOMAS DEWITT

Christopher W. Brody
Registration No. 33,613
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/4/2009 appealing from the Office action mailed 7/25/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,788,001	Narula	11-1988
6,153,208	McAtee	11-2000

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7, 9, 17-18, 20-21, 26, 37, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Narula (US Patent 4,788,001) in view of McAtee et al. (US Patent 6,153,208).

Narula teaches methods of making oil-in-water emulsions that are comprised of petrolatum (Col. 3, lines 18-19). Narula teaches that the emulsions are diluted with water (Col. 7, lines 42-47).

Narula does not teach heating the petrolatum up to 80°C, diluting the emulsion with water preheated up to 50°C, the addition of a preservative system (specifically DMDM hydantoin and iodo propynyl butyl carbamate), or the addition of hydrocortisone.

McAtee et al. teaches methods of making compositions with a conditioning emulsion comprised of an oil soluble conditioning agent, including petrolatum (Col. 25, line 58 and Col. 26, lines 13-21) and methyl glucose dioleate as the emulsifier (Col. 30, line 53). Active ingredients include hydrocortisone (meeting the limitation of claims 9, 20, 26-27 and 37-38; Col. 45, line 14 and Col. 48, line 8). Examples 6-10 state that the

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ingredients of the conditioning emulsion are mixed at between 75-115⁰C (further meeting the limitation of claims 6 and 17; Col. 54). Other ingredients that can be incorporated into the conditioning emulsion include Glydant Plus (meeting the limitations of claims 7, 21 and 39-41; Col. 47, lines 4-5).

Furthermore, it is obvious to vary and/or optimize the temperature to dilute the emulsion with water at 50⁰C provided in the composition, according to the guidance provided by McAtee et al., to provide a stable composition. It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is also noted that it has been held that merely changing the order of steps in a multi-step process is not a patentable modification absent a showing of unexpected results. *Ex parte Rubin* 128 USPQ 440 (POBA 1959).

Accordingly, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). In the instant case, one would have been motivated to make an absorption base comprised of petrolatum and methyl glucose dioleate because of the teachings of Narula and McAtee et al. that both agent are used as emulsifiers and it would be obvious to a person of ordinary skill in the art to make an absorption base with excellent emulsifying properties.

(10) Response to Arguments

Appellants argue that the teachings of McAtee and Narula are not so similar as to be combined. Appellants concentrate on the argument that McAtee excludes moisture in his formulation whereas Narula requires water in a specific amount. Appellant's focus on the teaching of McAtee that the composition of the invention is substantially free of water and is dry to the touch. Appellants further argue that the conditioning emulsion of McAtee is not an oil-in-water product but a water-in-oil composition.

Appellants further argue that McAtee does not render the heating steps in claims 6 and 17 obvious and point out that the instant claims require heating of the petrolatum prior to adding of the MGD or the non-lanolin based emulsifier. Appellants argue that McAtee uses high mixing temperature because of high melting point lipid hardness-increasing components used in the conditioning component but it would not be obvious to include this step in Narula because Narula expresses no need for a heating step. Appellants also argue that the fact that petrolatum and MGD are known as emulsifiers does not mean that the method described in claims 6 and 17 is obvious.

In response to the above arguments, it is noted that the primary reference used (Narula) teaches oil-in water emulsions that are comprised of petrolatum and water. While it is understood that McAtee teaches an article that provides conditioning benefits, it is also noted that within the teaching of an article, an emulsion is made and then added to the article. McAtee teaches that the emulsion requires an emulsifier of which includes methyl glucose dioleate as relied upon in the reference. McAtee further teaches that the emulsion is useful for providing conditioning benefits to the skin. As

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discussed in the rejection it is obvious to combine two compositions, in this case the emulsifiers, each of which is taught by the prior art to be useful for the same purpose in order to form a third composition for the very same purpose. Therefore it is obvious to combine two emulsifiers for maximal conditioning benefits. The emulsion portion of the composition of the McAtee et al. reference could be combined with Narula et al. to formulate an emulsion composition to condition the skin.

Further, McAtee teaches in Examples 6-10 that heating was performed to provide uniformity and does state that it is for lipid hardness. Therefore, the motivation for combining the heating step in the composition of Narula is for providing uniformity of the composition. Also, the same components are taught by McAtee et al. as in the present invention and the melting temperatures of the compounds are a property of the compound and the properties are inseparable. Therefore, the components were used for their emulsification properties in both inventions. It is further noted that McAtee was not used to teach water in the emulsion but to teach that conditioning emulsions can be formulated with the same components of the instant invention. Mixing two emulsifiers is an obvious modification because it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, it has been held that merely changing the order of steps in a multi-step process is not a

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patentable modification absent a showing of unexpected results. *Ex parte Rubin* 128

USPQ 440 (POBA 1959.)

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SREENI PADMANABHAN/

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